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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,588	07/12/2001	Yoshikado Sanemitsu	50006-111	9436

7590 03/13/2003
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WASHINGTON, DC 20005-3096

EXAMINER

LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,588

Applicant(s)

SANEMITSU, YOSHIKADO

Examiner

Uyen-Chau N. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Appeal Brief

1. Receipt is acknowledged of the Appeal Brief filed 17 January 2003.

Drawings

2. Figures 8A-8D and 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The indicated 103(a) of claims 1-5 are withdrawn in view of the newly discovered reference(s) to Kim (US 6,214,645) and Ferguson et al (US 5,394,609). The delay in citation of this art is regretted. Rejections based on the newly discovered prior art of record follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al (US 5,394,609).

Art Unit: 2876

Re claim 5, Ferguson et al discloses a small size PCMCIA card/mini-card 1 with an IC chip/a semiconductor memory device 25 comprising: a printed circuit board/substrate 23; a semiconductor memory device 25 mounted on the substrate 23; and a case comprising a top cover 11, a frame 31 and a bottom cover 15 covering the substrate 23; wherein a part of the substrate 23 is exposed to an external side of the case (see figs. 1-3; col. 1, line 55-63).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US 6,214,645) in view of Ferguson et al. The teachings of Ferguson et al have been discussed above.

Re claims 1-4, Kim discloses a method of manufacturing a card with an IC chip/a semiconductor memory device 40 comprising the steps of: providing a PCB 10, which serves as an array of substrates 11 including a plurality of individual substrates/chip plates 16 connected together (fig. 3); mounting a semiconductor memory device 40 on each of the individual substrates 16; covering the individual substrates 16 with respective cases comprising top 30a and bottom 30b; dividing, after the step of covering is completed, the substrate array 10 via cutting line 19' to provide encased individual substrates (fig. 5a) each completing the card having the semiconductor memory device 40 embedded therein; wherein during the covering step, each

Art Unit: 2876

substrate is sandwiched between top 30a and bottom 30b case segments (fig. 5a); and wherein during covering step, each substrate is molded in case (figs. 3-5a; col. 7, line 49 through col. 8, line 58).

Kim fails to teach or fairly suggest that the card is a mini-card.

Ferguson et al teaches a small size of PCMCIA card 1, which serves as a mini-card (see figs. 1-3; col. 1, line 55-63).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ferguson et al into the teachings of Kim in order to provide Kim with a more feasible system in manufacturing/fabricating process (i.e., the thinner and smaller size of the card, the less cost in materials, etc.). Furthermore, such modification would provide Kim with a more compact system wherein a mini-card can be carried along with the user at all due to its mini size (e.g., the mini-card can be carried in a small pocket or wallet, etc.).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Smulson (US 6,248,199); Leighton (US 5,817,207) and Leighton (US 6,514,367) are cited as of interest and illustrate a similar structure to a PC adapter cards and method of manufacturing the same.

Art Unit: 2876


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, T, F, SUN 9:30-7:00 and SAT 1:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Uyen-Chau N. Le

March 7, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800